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10/578,137

05/03/2006

Hiroataka Minami

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EXAMINER

NUTTER, NATHAN M

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/578,137 | Applicant(s) MINAMI ET AL. | |
| | Examiner Nathan M. Nutter | Art Unit 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 4 and 6 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3 and 5, drawn to an adhesive composition, classified in class 525, subclasses 232, 233, 238 and 241 and class 524, subclasses 515, 521, 525 and 526.
- II. Claims 4 and 6, drawn to an automobile door, classified in class 49, subclasses 502 and 227 and class 160, subclasses 37 and 103.

The inventions are independent or distinct, each from the other because:

Inventions of Group I and of Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a different adhesive composition, or different window arrangement may be employed (as in swivel windows). The subcombination has separate utility such as a molding composition for gaskets.

Since applicant has received an action on the merits for the originally presented invention, being claim 1, this invention has been constructively elected by original

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presentation for prosecution on the merits. Accordingly, claims 4 and 6 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

There is no disclosure to support the recitation of "consist," to exclude other constituents. No example is provided that is so limiting, nor description that clearly indicates such limitation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Obrecht et al (US 6,184,296).

Note column 1 (line 50) to column 3 (line 3) for the first rubber component and column 4 (lines 5-40) for the second component. The use of fillers is taught at column 4 (line 43) to column 5 (line 20). The employment of antioxidants and plasticizers is disclosed at column 5 (lines 19-27). The compositional limitation is shown at column 1 (lines 37-46).

Response to Arguments

Applicant's arguments filed 19 April 2010 have been fully considered but they are not persuasive.

With regard to the rejection of claims 3 and 5 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, the Examiner agrees "consisting of" is deemed to exclude "any element or ingredient not specified therein. Applicants have failed to show they have provided such exclusion of other constituents, either by direct disclosure or by Example. Applicants opine the passage cited at page 4, second complete paragraph, provides for the use of only those constituents being "partially crosslinked NBR and/or SBR, a plasticizer and a filler" and "uncrosslinked synthetic rubber." The passage clearly, as quoted by applicants, states "comprises the above partially crosslinked NBR and/or SBR, a plasticizer and a filler." This statement fails to exclude constituents. Further, at (lines 12-14), the reference provides for inclusion of "the above uncrosslinked synthetic rubber " which are taught at page 3 (lines 16-20) to include "acrylonitrile-isoprene rubber (NIR), NBR, SBR, butadiene rubber, isoprene rubber and the like (emphases added)." The statement is both open-ended, and teaches constituents that the recitation "consisting of" excludes.

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The subject matter of the claims must be described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. This has not been shown by applicants.

With regard to the rejection of claims 3 and 5 under 35 U.S.C. 102(b) as being clearly anticipated by Obrecht et al (US 6,184,296), it is first pointed out that applicants' quotation of the Obrecht et al at column 1 (lines 50-52) and column 2 (line 26) does not read as reported, e.g. "(r)ubber gels are taken to mean microgels (A) produced by crosslinking..., uncrosslinked rubber starting products." That passage recites "(r)ubber gels are taken to mean microgels (A) produced by crosslinking---[list of rubbers employed]---, or mixtures thereof." As pointed out above, the components are all shown. Applicants argue the "rubber mixtures" are due to a mixture of rubber (A) with a mixture of rubber (B). This is not the case. The reference requires only one of each, not all of both. Thus, the reference does not teach the mixing of all of the recited rubbers, but to the various combinations that may be produced from the various rubbers, (A) and (B). The instantly claimed composition is producible from the combinations available in the reference. Further, applicants have not shown that the reference materials are fully cross-linked. The term "partially cross-linked" has not been defined as to scope, or been differentiated over the reference. Applicants are reminded that in composition claims, the method of production does not provide patentable weight to claims, except in a showing of criticality thereto. The reference shows the isolation of the rubber products at

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each of column 6 (lines 56-58) and column 7 (lines 2—22 and 58-60). In response to applicant's argument that the examiner's conclusion of anticipation is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As to the properties recited in claim 5, these properties would be inherent in the composition since there are no other existing differences in the scope of the constituents. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

6 May 2010